

REMARKS

Prosecution Summary. In light of the USPTO's current policies on compact prosecution, it is noted that the pending application was filed nearly seven (7) years ago on October 24, 2003 with 25 claims. The first office action was filed three years nine months later on July 24, 2007. The presently addressed seventh office action was mailed July 21, 2010.

Claim Summary. Claims 1-25 are pending. Claims 1, 8, and 16 are independent. Claims 1, 8, and 16 are amended. No claims are added. No new matter is added.

Office Action Summary. Claims 1-25 are rejected under 35 U.S.C. § 112 and are again rejected under 35 U.S.C. 35 § 103(a).

Remarks summary. Applicants respectfully traverse the rejections. As explained in detail below, it is respectfully submitted that the claims are allowable over the asserted art. Reconsideration and withdrawal of the rejections in view of the following remarks is respectfully requested.

References to the Pending Application. Reference to paragraphs in the pending application are to the numbered paragraphs in the Published Application No. 2005/0091168.

Telephone Conversation With Examiner

Examiner Murdough is thanked for the telephone conversation conducted on October 5, 2010. Proposed amendments were discussed. Clarifying amendments were discussed. It appears that in view of the proposed and clarifying amendments, and the herein remarks, all rejections are overcome.

Rejection of Claims 1-25 under 35 U.S.C. § 112

Claims 1-25 are rejected under 35 U.S.C. 35 § 112 as allegedly being indefinite. (Office Action, pp. 2-3). Claims 1-7 are rejected for a first reason and claims 1-25 are rejected for a second reason. Applicants respectfully traverse.

First, regarding the rejection of claims 1-7, the Office Action argues that executing computer executable instructions to provide a licensing component makes it unclear whether the licensing component is executed. Although it is submitted that claim 1 is clear, and that one of ordinary skill in the art would easily comprehend that stored instructions actually provide functionality only when executed by a processor, it an effort to advance prosecution, claim 1 is amended to recite “computer-executable instructions, ~~when executed, providing comprising:~~ a licensing component.”

Second, regarding the rejection of claims 1-25, the Office Action argues, referring to claims 1, 8, and 16, that “it is impossible to properly construe” “same computer program” so, instead, the Office Action will construe it as “different computer program.” This rejection truly is not understood. Thus, to avoid confusion, the term “same” is removed from claims 1, 8, and 16. Further, in view of the aforementioned telephone conversation, claims 1, 8, and 16 are amended for clarification to recite that a computer program comprises a set of instructions.

Accordingly, it is requested that the rejection of claims 1-25 under 35 U.S.C. 35 § 112 be reconsidered and withdrawn.

Rejection of Claims 1-25 under 35 U.S.C. § 103(a)

Claims 1-25 are again rejected under 35 U.S.C. 35 § 103(a) as unpatentable over U.S. Patent No. 6,047,242, issued to Benson (hereinafter referred to as “Benson”) in view of U.S. Patent No. 5,629,980, issued to Stefik et al. (hereinafter referred to as “Stefik”) and also, only with respect to claims 2, 6, 7, 15, 19 and 21-23, U.S. Patent Application Publication No.

2003/0088516, by Remer et al. (hereinafter referred to as "Remer"), and also only with respect to claims 4, 11-14, 18, 24 and 25, U.S. Patent No. 6,115,777, issued to Zahir et al. (hereinafter referred to as "Zahir"). (Office Action, pp. 3-11). Applicants respectfully traverse.

All three independent claims 1, 8, and 16 are rejected using the same argument based on Benson and Stefik, on pages 4-6 of the Office Action. Therefore, the following remarks apply equally well to all claims 1-25. The foregoing remarks regarding the rejections under 35 U.S.C. § 112 apply equally well here given that the Office Action indicates on page 11 that its rejections under 35 U.S.C. §§ 112 and 103 are linked.

The claims specify a callable interface to the licensed program to provide it with licensing information so that the program can enforce a license. In contrast, neither Benson nor Stefik allows this. In Benson, the challenge mechanism is an enforcer that allows or permits use. In Stefik, repository 1 using rights grammar FIG. 15 is the enforcer. Thus, there is no point, in Benson and Stefik, to providing a callable interface to provide licensing information to the licensed program.

Benson and Stefik pertain to a different type of rights enforcement than the claimed subject matter and, as a result, fail to teach or suggest any portion of the claimed subject matter. The following remarks highlight several limitations that the references fail to teach or suggest.

First, on page 4, the Office Action merely cites "Figure 3" of Benson without any explanation. This is ambiguous and fails to give Applicants fair notice of the argument being made. In any event, FIG. 3 does not teach or suggest that Benson's software 103 is subject to a plurality of licenses permitting different rights in software 103, which is required by the claims.

Nowhere does Benson teach or suggest that software 103 is subject to use under a plurality of licenses each permitting different rights in software 103. Further, the fact that Benson states in column 16, lines 64-66 that a plurality of customers, each with their own copy of software 103 could share license server 120 also does not teach or suggest that software 103 is

subject to a plurality of licenses each permitting different rights in software 103, as opposed to merely different users each with the same license and the same rights. Further still, at column 2, line 66 – column 3, line 8, Benson discusses rights in a license, not different rights in different licenses for the same software.

In accordance with software 103 being subject to one license, all that Benson's license server 20 does is confirm that the customer has access to the private key counterpart to the public key embedded in keyfile 105. If the customer proves he/she has access then the customer can use the software according to the license.

Second, at column 16, lines 64-66, Benson states only that a plurality of customers, each with their own copy of software 103 could share license server 120. This does not teach or suggest that software 103 is subject to a plurality of licenses each permitting different rights in software 103 or that ECP (the alleged licensing component) is common to a plurality of licenses each permitting different rights in the software as required by the claims. In other words, all the Office Action cites to is ECP can be common to a plurality of licenses (the same license giving the same rights held by different users), but not to a plurality of licenses each with different rights in the software.

Third, Benson's statement in column 2, line 66 to column 3, line 8, that when a license is granted by a license server the license server modifies an access control list (ACL) to permit licensed software to access a file does not remotely teach or suggest (i) that a license comprises an ACL or (ii) an information-retrieval (I-R) component in a callable interface, let alone the claimed I-R component that receives an identifier of a right from a licensed program and in return provides information associated with the right to the licensed program.

(i) An ACL controlled by license server 20 does not make an ACL part of a license. Rather, the ACL is modified to add the customer to it in accordance with a license to access a resource.

(ii) The claims specify that the I-R component is part of the callable interface. The Office Action equated Benson's challenge mechanism 24 to the claimed callable interface. Of course Benson's challenge mechanism 24 is not even a callable interface, but even if it was, in order to make an argument consistent with the claims the Office Action is required to cite a part of challenge mechanism 24 to even begin to make an argument about the claimed I-R component that is part of the callable interface. However, Benson's server 20 is not part of its challenge mechanism 24. Instead, the Office Action cites Benson's server 20 as the claimed license store. The server controlling the ACL merely grants or denies access to a controlled resource (file) based on the ACL; it doesn't return the ACL in response to attempts to access the file.

Fourth, the claims require that a callable interface be exposed to the licensed program to provide licensing information to it. Benson's challenge mechanism 24 is not callable by protected software 103. The Office Action seems to assume this, but nowhere cites any teaching or suggestion in Benson to prove it. Challenge mechanism 24 is an enforcer, not a provider of licensing information to software 103.

Fifth, the Office Action turns to Stefik with respect to the claimed right-consumption component. An obvious problem with Stefik is that what is alleged to be a right consumption component (e.g. Stefik's repository 1) does not receive an identifier of a right from the digital work itself, which the claims require. Instead, for example as shown in FIG. 1 and discussed with regard thereto, Stefik's repository 1 receives a request from repository 2 to access the digital work. The alleged right-consumption component does not receive an identifier from the digital work. The Office Action doesn't cite any portion of Stefik regarding this detail and appears to have overlooked it in the claims.

Furthermore, the Office Action's block citation to 10 columns in Stefik is improper. The Examiner can not essentially tell Applicants, look, somewhere in these ten columns you might find whatever it is I'm thinking. Such massive block citations are far too ambiguous to be useful during prosecution.

Sixth, the Office Action fails to explain how it would have been obvious to inject Stefik's repository 1 or FIG. 15 usage rights grammar into Benson's challenge mechanism 24 when it isn't even a callable interface. The Office Action fails to present a *prima facie* rejection by merely concluding it is obvious to combine tens columns from Stefik with Benson. No explanation is provided as to what elements would be combined or how they would be combined. And, no explanation is provided regarding the resultant functionality of a combination.

The foregoing remarks rebutting the rejection of claim 1 apply in whole to the rejection of claims 2-7 and at least in part to the rejection of claims 8 and 16, and all claims depending thereon. Remer and Zahir, cited only with respect to dependent claims 2, 4, 6, 7, 11-15, 18, 19 and 21-25, fail to teach or suggest what Stefik and Benson fail to teach or suggest with respect to independent claims 1, 8 and 16.

For at least the foregoing reasons, it is respectfully submitted that the arguments in the Office Action clearly lack merit. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-25.

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PATENT

CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that this application is in condition for allowance. Reconsideration of this application and an early Notice of Allowance are respectfully requested.

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